

Claims 20 and 26-30 have again been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 6-9 of Applicant's U.S. Patent No. 5,704,835. With Applicant's submission of an appropriate "Certificate Under 37 C.F.R. § 3.73(b)," this basis of rejection is now moot.

B. Prior Art Rejections

1. The Invention

Applicant has invented a variation of the popular electronic slot machine game in which up to all of the electronically generated symbols arrayed in multiple symbol columns and rows can be individually replaced after an initial array of symbols is generated. An apparatus to implement Applicant's electronic slot machine game includes a monitor for displaying the array of symbols, a memory which stores a list of possible symbols, a microprocessor to select symbols from the memory, a first switch to initiate game play and a second switch to allow for a respin of selected symbols. In one alternative embodiment, both the symbols and their background colors can be respun to add further variability and enjoyment to the game.

2. The Cited Art Distinguished

Claims 1-17 have been rejected under 35 U.S.C. § 103(a) as being obvious over Dabrowski's U.S. Patent No. 5,356,140 ("Dabrowski patent") in view of Manship's U.S. Patent No. 5,393,061 ("Manship patent").

On the issue of "obviousness," the Patent Office bears the burden of establishing a case of *prima facie* obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed.Cir. 1988). To determine whether or not the claimed subject matter can properly be viewed as being "obvious" under 35 U.S.C. § 103, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved....Such secondary considerations as commercial success, long felt but unsolved need, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966); *see*

also *Ruiz v. A.B. Chance Company*, \_\_\_ F.3d \_\_\_, 2000 WL 1783236, p. 10 (Fed.Cir., Dec. 6, 2000).

Courts have found secondary considerations to be particularly important because they “guard against slipping into use of hindsight’ ... and to resist the temptation to read into the prior art the teachings of the invention at issue.” *Graham supra*, 383 U.S. at 35-36; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed.Cir. 1983)(“[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.”). Moreover, in order to properly combine references for an obviousness determination, there must be a suggestion or motivation in the references to make such a combination. *In re Gordon*, 733 F.2d 900, 902 (Fed.Cir. 1984)(“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification”); *Ruiz, supra*. With these legal principles in mind, the merits of the obviousness rejections will now be addressed.

As noted by the Examiner, the Dabrowski patent discloses a video *poker* game. In the Dabrowski poker game, two poker hands are simultaneously dealt with one hand superimposed upon the other. The player then chooses which hand to play and “the unselected hand is voided or removed from use” (Dabrowski patent abstract).

Applicant’s invention is *not* directed to a video poker game but rather a variation of the popular electronic *slot machine*. To make this point clear, Applicant has stated in each of his claims that the monitor displays a plurality of symbols “arrayed in multiple symbol columns and rows.” The Dabrowski video poker game, like other video poker games, does not have a plurality of symbols “arrayed in multiple symbol columns and rows.” Instead, Dabrowski shows only a *single* row of superimposed cards at the beginning of the game which quickly becomes simply a single row of individual cards as the game is played. As such, since the Dabrowski patent discloses an entirely different game than being claimed by Applicant, the Dabrowski patent does not teach the subject matter of Applicant’s claims 1-17.

To show the existence of a game in which symbols are displayed in multiple rows and columns, the Examiner cites the Manship patent. For its part, Applicant does not dispute that electronic slot machine games, of the type shown in the Manship patent, have been in use for many years. What Applicant does dispute is that, prior to Applicant’s invention,

electronic slot machine games were known which allowed the type of individual symbol respin capabilities disclosed and claimed by Applicant (see, Dietz Decl., ¶ 2). The Manship patent certainly fails to disclose any such individual symbol respin capabilities. Moreover, neither the Examiner for Applicant's issued patent, U.S. Patent No. 5,704,835, nor the present Examiner has been able to find any *slot machine* prior art reference with such disclosure.

Given the enormous popularity of slot machine gaming, if it were so "obvious" to add individual symbol respin capability to an electronic slot machine game, it would have been done long before Applicant's invention. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999)("the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"). The fact that there is no such prior art and Applicant's competitors have now been quick to copy Applicant's invention provides strong "secondary consideration" support for a finding of non-obviousness (Dietz Decl., ¶ 2-4). *In re Beattie*, 974 F.2d 1309, 1313 (Fed.Cir. 1992)(secondary consideration evidence "may be sufficient to overcome a prima facie case of obviousness"). For these reasons, the Examiner's proposed combination of the Dabrowski and Manship patents would not render as "obvious" the subject matter of Applicant's claims 1-17.

Claims 18-19 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Dabrowski patent in view of either the Manship patent or Bennett's U.S. Patent No. 6,056,642 ("Bennett patent"). With respect to the Dabrowski patent, the Examiner acknowledges that the Dabrowski patent lacks disclosure of allowing the player to select background colors for replacement. The Manship patent discloses a slot machine game having display colors. In a so-called "Fever Mode," Manship's display colors are enhanced and the payout table is changed (see, col. 5, lns. 13-41 and col. 7). In its Abstract, the Bennett patent discloses that when a certain combination of numerical symbols appears after the only spin (e.g., three 7's), the slot machine can then choose to backlight those symbols with different colors (e.g., red, white or blue) and change the payout depending on the backlit colors. Like other common slot machines, there is no provision in either the Manship nor the Bennett patents for allowing the *player* to select one or more symbols or colors for replacement after the initial spin. As such, both Manship's and Bennett's slot machines are entirely games of chance whereas Applicant's respin slot machine involves an important element of skill (i.e.,

choosing which slot machine symbols or colors to replace). For these reasons, neither the Manship nor the Bennett patents provide the claimed disclosure missing from the Dabrowski patent.

Claims 20-30 have been rejected as being unpatentable over the Dabrowski patent or Heidel's U.S. Patent No. 5,342,047 ("Heidel patent") in view of the Manship patent. The deficiencies in the Dabrowski and Manship patents have already been discussed. Contrary to the Examiner's position, the Heidel patent disclosure proves, if anything, that Applicant's slot machine respin invention is *not* obvious. As noted by the Examiner, the Heidel patent discloses a typical video poker game with a *single* row of gaming cards, one which allows cards to be selected for replacement (i.e., by pressing buttons 32a-32e). The Heidel patent also discloses a video slot machine game in Fig. 2a. In describing this video slot machine game, Heidel parrots the conventional wisdom in the art prior to Applicant's invention that *one cannot have a respin capability on an electronic slot machine game*:

"When a game other than poker, *such as the slot machine game of FIG. 2a*, is selected by the player, the computer 50 is programmed to not accept inputs from the control button circuit 74. *Touching the game control buttons 32a-32e will therefore have no effect on the game*" (Heidel patent, col. 3, lns. 43-47; emphasis added).

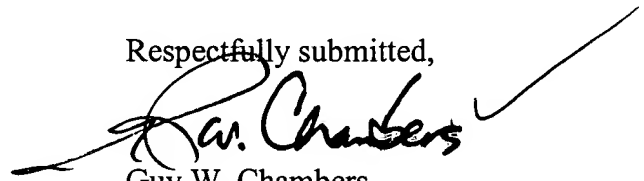
Since the Heidel patent strongly teaches away from Applicant's invention, it is clear that Heidel cannot be combined with Dabrowski and/or Manship to render Applicant's claims 20-30 as "obvious."



CONCLUSION

In light of the previous remarks and amendments to the claims, Applicant submits that the present application is now in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. To the extent that the Examiner believes that there are still formal matters or issues of patentability remaining, the undersigned attorney requests the opportunity for an interview with the Examiner to discuss these issues. The undersigned attorney for Applicant can be reached at (415) 576-0200 to schedule such an interview.

Respectfully submitted,

  
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